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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,751	08/30/2001	Dan Stoianovici	56436(71699)	8459

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EXAMINER

NGUYEN, VI X

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,751

Applicant(s)

STOIANOVICI ET AL.

Examiner

Victor X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 29-36, 38, 39 and 42-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 29-36, 38, 39 and 42-54 is/are rejected.
- 7) ☒ Claim(s) 27, 28, 40 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/02/2004 has been entered.

Specification

2. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood in claims 1, 16, 26, 29, 42 and 44-48: The embodiment of figures 2 and 3, as described in the specification and shown in the drawings on 12/17/2003, is incapable of being used. It is unclear from the specification and drawings how a device for placing **a proximal portion of a penetrating member** in a target are after **the apparatus is positioned in proximity to an entry point of an object containing the target area** by a manipulation device, and where **the manipulation device can position the apparatus in proximity to the entry point of the object containing the target area**. Since the manipulation device as best seen in fig. 3 of the application clearly indicates that the apparatus is in **distal** to the entry point of the object containing the target area (distal to element 154b).

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

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Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15, 17-26, 29-39 and 42-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following items are not understood: The embodiment of figures 2 and 3, as described in the specification and shown in the drawings on 12/17/2003, is incapable of being used. It is unclear from the specification and drawings how a device for placing a **proximal portion of a penetrating member** in a target area after **the apparatus is positioned in proximity to an entry point of an object containing the target area** by a manipulation device, and where **the manipulation device can position the apparatus in proximity to the entry point of the object containing the target area**. Since the manipulation device as best seen in fig. 3 of the application clearly indicates that the apparatus is in **distal** to the entry point of the object containing the target area (distal to element 154b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 16, 26, 29, 42 and 46 are rejected under 35 U.S.C. 102 (b) as being anticipated by Ng (5,820,623).

Ng discloses in figures 1-2, a device for percutaneous surgery in a soft tissue target, including: a first arm (124) is configured and arranged to support the penetrating member (179), a first drive mechanism (302) is coupled to the first arm and configured to translate the first arm from an initial position to any of a number of other positions from the initial position, thereby also translating the penetrating member towards the target area, where the first arm and the first drive mechanism are coupled to the manipulation device (137), and where the first drive mechanism (302) includes a linear guide (see col. 5, lines 1-6), where a second drive mechanism (304) is coupled to the penetrating member (179) and is configured to cause the penetrating member to rotate , and where the second drive mechanism comprises a gear member (120) secured to the penetrating member and coupled to a motor (119), and where a second arm (125) is coupled to the first drive mechanism (302), where the second drive mechanism is coupled to the penetrating member (179) so as to cause the penetrating member to rotate about the long axis of the penetrating member.

Allowable Subject Matter

5. Claims 27-28 and 40-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art of record, alone or in combination, discloses all of the limitations of claims 27-28 and 40-41 including, the second drive mechanism further includes a drive gear that is mechanically coupled to the motor and the penetrating member gear

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member so that the penetrating member gear member rotates responsive to rotation of the drive gear, and where the motor is a bi-directional motor where the penetrating member can be rotated in one of a clockwise and counter clockwise direction responsive to the direction of rotation of the motor.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

6. Applicant's arguments with respect to claims 1, 16, 26, 29, 42 and 46 have been considered but are moot in view of new ground(s) of rejection. Applicant is asked to please refer to the modified prior art rejection above where examiner addresses applicant's concerns regarding prior art rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen
Examiner
Art Unit 3731

Vn *✓*
1/7/2005



JULIAN W. WOO
PRIMARY EXAMINER